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Response to Office Action Dated 12/31/2003

**REMARKS**

Applicant appreciates the telephonic Examiner Interview of March 24, 2004 and respectfully requests reconsideration and allowance of the subject application. Claims 1-2, 4-33 are pending in this application.

**Claim Amendments**

Claims 1-38 were previously pending.

Claims 34-38 were restricted as a separate invention by the Examiner, so while still in the application are withdrawn as being a non-elected invention.

Claims 1, 2, 10, 13, 17, 19, 23, 25, 29 are amended.

Claim 3 is cancelled.

No new claims are added.

Claims 1-2, 4-33 are currently pending.

**Election/Restriction**

The Office has withdrawn claims 34-38 as being directed to a separate invention than claims 1-33. Claims 1-33 are elected as being already involved in prosecution.

**Context of Applicant's Subject Matter**

A brief overview of the context of the subject matter—that is, of the prior art “problem to be solved” by Applicant’s subject matter—is presented to refresh the Examiner’s review of the application, namely:

“...during each synchronization process, if an object has been deleted on the portable computer or the base computer since the last synchronization process, then the corresponding object on the other system is also deleted. Thus, if a memory card containing a previously synchronized object is removed from the portable computer, then a synchronization process will delete the

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previously synchronized object from the base computer.” (Applicant’s specification, p. 3, lines 11-16).

Applicant’s specification thus sets the context or environment in which the claimed subject matter is practiced. Applicant’s subject matter is directed to improving systems that use a synchronization process that tries to delete an object on a first device if a corresponding object is not accessible to a second device.

**References Cited by Examiner are not Admitted by Applicant as Prior Art**

The Office Action frequently refers to the references cited by the Examiner as “Admitted Prior Art” also abbreviated in the Office Action as “APA.” The terms Admitted Prior Art and APA might be mistaken to mean that Applicant has made an evidentiary admission that these cited references are prior art. Applicant has made no such admission, but to the contrary has specifically maintained and vigorously argued in all responses to Office Actions that the references cited by the Examiner are not prior art references against Applicant’s subject matter. Hence, Applicant respectfully objects to use of the terms “Admitted Prior Art” and “APA” when referring to cited references.

**Rejection of the Claims**

**35 U.S.C. § 112, second paragraph**

Claims 1-12 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter set forth therein.

35 U.S.C. § 112, second paragraph states: “The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.”

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The formality identified in the Office Action has been addressed in this Amendment. The word "occasionally" has been deleted. Claim 1 has been amended to more particularly point out and distinctly claim the subject matter—that is, to add clarity—without prejudice to the scope of the claim.

Since the language objected to by the Examiner has been deleted, Applicant now respectfully requests that the 35 U.S.C. § 112, second paragraph rejection be withdrawn for claim 1 and also for claims 2-12, which depend from claim 1.

35 U.S.C. § 103(a)

Claims 1-33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,884,323 to Hawkins ("Hawkins") in view of U.S. Patent No. 5,887,145 to Harari et al. ("Harari") further in view of U.S. Patent No. 5,774,717 to Porcaro ("Porcaro") further in view of logical reasoning. Applicant respectfully traverses these rejections.

It should be noted once again that claim 1 has been amended to add clarity without prejudice to its scope, and in the process overcomes a 35 U.S.C. 112 second paragraph rejection as well, as explained above.

Claim 1: The Office has failed to present a prima facie case of obviousness.

- A. No evidence is presented by the Patent Office to motivate or suggest combination of references.

As stated in MPEP § 2143.01, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found

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either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). *The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.* (Emphasis added.) In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

The combinations of Hawkins, Harari, Porcaro, and logical reasoning do not support a prima facie case of obviousness under 35 U.S.C. § 103(a). As stated in MPEP § 2143, to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Because the cited references are generally directed to synchronization systems in which objects that are available on one device but unavailable on the other device are ignored during synchronization or brought to the attention of a user instead of deleted, the cited references contain no motivation to combine with each other to constructively produce subject matter of automatic prevention of object deletion.

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- B. Even assuming evidence to motivate or suggest the combination existed, the references still fail to disclose, teach or suggest all claim limitations.

As stated in MPEP § 2143.01, to establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Applicant's subject matter of automatically preventing deletion of objects during synchronization processes that try to automatically delete such objects is not disclosed, taught, or suggested by any of the cited references, either singly or in combination.

- C. Even assuming a motivation or suggestion to combine existed and discrete subject matter disclosed, taught or suggested, the references fail to teach or suggest the claimed subject matter as a whole.

As stated in MPEP § 2141.02, in determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. Distilling an invention down to the "gist" or "thrust" of an invention disregards the requirement of analyzing the

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subject matter "as a whole." W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

Applicant's subject matter teaches particular systems and methods for synchronizing objects between two devices. The combination of references cited by the Office does not render Applicant's subject matter "as a whole" obvious in much the same way that a technical dictionary containing all the words in Applicant's specification would not render Applicant's subject matter obvious.

D. The Patent Office must refrain from hindsight reconstruction and view references and claimed subject matter with a proper temporal perspective.

With regard to pre-amended claim 1, Examiner combines four different references to reach an obviousness rejection: Hawkins, Harari, Porcaro, and logical reasoning (p. 6, lines 9-17). In line with MPEP § 2143.01, Applicant maintains that a motivation to combine these four different references as well as the desirability of doing so was lacking at the time of Applicant's invention. Additionally, Applicant maintains that needing a combination of three or four different references to show obviousness tends to demonstrate nonobviousness instead of obviousness.

With regard to MPEP § 2143.01 mentioned above (that is, to establish prima facie obviousness of a claimed invention all the claim limitations must be taught or suggested by the prior art) none of the references cited by the Office disclose, teach, or suggest all Applicant's subject matter, for example, do not disclose, teach, or suggest automatic prevention of object deletion during a synchronization process that normally deletes objects.

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Applicant respectfully requests that the 35 U.S.C. § 103(a) rejection be withdrawn from claim 1, and suggests that claim 1 is in condition for allowance.

#### Claims 2-12

Claim 2 is rearranged for consonance with language in claim 1, without narrowing claim 2. Claim 3 is cancelled as rearrangement of claims 1 and 2 captures subject matter of claim 3. Claim 10 is also amended merely to add clarity without narrowing the claim.

For at least the reasons set forth above with respect to claim 1, Applicant submits that claim 2 and claims 4-12 are patentable over the combination of Hawkins in view of Harari in view of Porcaro in view of logical reasoning. Dependent claims contain the language of the claims from which they depend. If an independent claim is nonobvious under 35 U.S.C. 103(a), then claims depending from the independent claim are also nonobvious. Claims 2, 4-12 depend from claim 1. Therefore, claims 2, 4-12 are also nonobvious.

#### Claim 13

Claim 13 has been amended to more particularly point out and distinctly claim the subject matter by clarifying that a base computer attempts to delete objects during synchronization if corresponding objects are not accessible to a portable computer." This amendment does not narrow the scope of the claim but merely offers a description of a prior art circumstance for practicing the method. For the same reasons explained above for claim 1, Applicant respectfully suggests that claim 13 is also nonobvious and allowable.

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Claims 14-18

For at least the reasons set forth above with respect to claim 13, Applicant submits that claims 14-18 are patentable over combinations of Hawkins, Harari, Porcaro, and logical reasoning. Dependent claims contain the language of the claims from which they depend. If an independent claim is nonobvious under 35 U.S.C. 103(a), then claims depending from the independent claim are also nonobvious. Claims 14-18 depend from claim 13. Therefore, claims 14-18 are also nonobvious.

Claim 17 has been amended to include synchronizing objects stored on an inaccessible removable storage device when the removable storage device becomes accessible, similar to claim 11. Thus, a base computer continues to allow changes to an object during inaccessibility of a corresponding object on a portable computer and then brings the inaccessible object up to date when the removable storage device containing the object becomes accessible to the portable computer.

Claim 19

Claim 19 has been amended to more particularly point out and distinctly claim the subject matter by clarifying that a base computer attempts to delete objects during synchronization if corresponding objects are not accessible to a portable computer. This amendment does not narrow the scope of the claim but merely offers a description of a prior art circumstance for practicing the method. For the same reasons explained above for claim 1, Applicant respectfully suggests that claim 19 is also nonobvious and allowable.



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Claims 20-24

For at least the reasons set forth above with respect to claim 19, Applicant submits that claims 20-24 are patentable over combinations of Hawkins, Harari, Porcaro, and logical reasoning. Dependent claims contain the language of the claims from which they depend. If an independent claim is nonobvious under 35 U.S.C. 103(a), then claims depending from the independent claim are also nonobvious. Claims 20-24 depend from claim 19. Therefore, claims 20-24 are also nonobvious.

Claim 23 has been amended to include synchronizing objects stored on an inaccessible removable storage device when the removable storage device becomes accessible, similar to claim 11. Thus, a base computer continues to allow changes to an object during inaccessibility of a corresponding object on a portable computer and then brings the inaccessible object up to date when the removable storage device containing the object is plugged back into the portable computer.

Claim 25

Claim 25 has been amended to more particularly point out and distinctly claim the subject matter by clarifying that a synchronization process occurs between a first device and a second device in which the first device is capable of communicating with a storage volume that can become inaccessible to the first device and the second device tries to delete objects on the second device that are not accessible on the first device, and therefore the instructions on the computer media prevent deletion of objects corresponding to objects on previously accessible storage volumes.

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This amendment does not narrow the scope of the claim but merely offers a description of a prior art circumstance for practicing the method. For the same reasons explained above for claim 1, Applicant respectfully suggests that claim 25 is nonobvious and allowable.

#### Claims 26-28

For at least the reasons set forth above with respect to claim 25, Applicant submits that claims 26-28 are patentable over combinations of Hawkins, Harari, Porcaro, and logical reasoning. Dependent claims contain the language of the claims from which they depend. If an independent claim is nonobvious under 35 U.S.C. 103(a), then claims depending from the independent claim are also nonobvious. Claims 26-28 depend from claim 25. Therefore, claims 26-28 are also nonobvious.

#### Claim 29

Claim 29 has been amended to more particularly point out and distinctly claim the subject matter by clarifying that synchronization occurs in a system that tries to delete objects during synchronization if the objects are not accessible to a peripheral computer. This amendment does not narrow the scope of the claim but merely offers a description of a prior art circumstance for practicing the method. For the same reasons explained above for claim 1, Applicant respectfully suggests that claim 29 is also nonobvious and allowable.

#### Claims 30-33

For at least the reasons set forth above with respect to claim 29, Applicant submits that claims 30-33 are patentable over combinations of

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Hawkins, Harari, Porcaro, and logical reasoning. Dependent claims contain the language of the claims from which they depend. If an independent claim is nonobvious under 35 U.S.C. 103(a), then claims depending from the independent claim are also nonobvious. Claims 30-33 depend from claim 29. Therefore, claims 30-33 are also nonobvious.

### CONCLUSION

Applicant respectfully suggests that claims 1-2, 4-33 are in condition for allowance. Applicant respectfully requests reconsideration and issuance of the subject application. Should any matter in this case remain unresolved, the undersigned attorney respectfully requests a telephone conference with the Examiner to resolve any such outstanding matter.

Respectfully Submitted,

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